



ATTORNEY DOCKET NO. 21101.0047U2
PATENT

1637

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Kevin M. Flanigan, *et al.*

Application No. 10/539,178

Filing Date: January 23, 2006

For: RAPID DIRECT SEQUENCE ANALYSIS
OF MULTI-EXON GENES

Art Unit: 1637

Examiner: Teresa E. Strzelecka

Confirmation No. 2241

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

NEEDLE & ROSENBERG, P.C.
Customer Number 23859

June 27, 2007

Sir:

In the Office Action dated May 30, 2007, the Examiner has restricted the claims and has required an election of one of following two groups under 35 U.S.C. §§ 121 and 372.

GROUP I Claims 1-18, drawn to a method of characterizing a nucleic acid region by performing amplifications in different reaction chambers, followed by sequencing of the amplications and analyzing the sequences of the amplicons; and

GROUP II Claims 19-20, drawn to a primer set comprising primers in Tables 1, 2, 6 or 7.

The Examiner also required an election of species in the present application. For Group I, the species are:

- A) Dystrophin,
- B) SOD-1,
- C) NF-1,
- D) ATM,
- E) Dysferlin,
- F) Calpain,

- G) Sarcoglycans,
- H) Collagen VI,
- I) Nebulin, and
- J) Titin

For Group II, the species are a single primer set.

As required in response to this Action, Applicant elects Group I, Claims 1-18, with traverse. Applicant further elects Species A, the multi-exon gene dystrophin. Claims 1-18 are believed to read on the elected species.

Applicant respectfully requests that the restriction requirement be reconsidered. For a restriction requirement to be proper, the Examiner must satisfy the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. § 121); and (2) that the search and examination of the entire application cannot be made without *serious burden* on the Examiner. M.P.E.P. § 803 provides:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. (*Emphasis added.*)

Applicant respectfully submits that the Examiner has not shown that the second requirement has been met. Specifically, there has been no showing that it would be a *serious burden* to search and examine the two groups together.

For the reasons stated above, Applicant respectfully asserts that restriction of the claims as set forth by the Examiner would be contrary to promoting efficiency, economy and expediency in the Patent Office and further point out that restriction by the Examiner is discretionary (M.P.E.P. § 803.01). Examining all of the claims together would eliminate the necessity of prosecuting multiple, separate, yet intimately related applications. Thus, Applicant respectfully requests that all of the claims of this application be examined together. Consequently, reconsideration and modification or withdrawal of the restriction requirement is requested.


CONCLUSION

Group I (Claims 1-18) and Species A (the multi-exon gene dystrophin) have been elected with traverse. Claims 1-20 are pending.

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No fees are believed to be due; however, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment in fees to Deposit Account No. 14-0629.

Respectfully submitted,
NEEDLE & ROSENBERG, P.C.

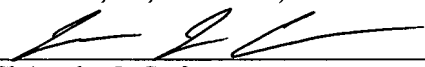


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CERTIFICATE OF MAILING UNDER 37 CFR § 1.8

I hereby certify that this correspondence and the documents mentioned therein are being deposited with the United States Postal Service in an envelope addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450, on the date indicated below



Christopher L. Curfman

June 27, 2007

Date